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PCT LEGAL ADMINISTRATION

In re Application of :
KOHNO *et al* :
U.S. Application No.: 10/585,985 :
PCT No.: PCT/JP2005/000737 :
Int. Filing Date: 21 January 2005 :
Priority Date: 21 January 2004 :
Attorney Docket No.: 80441(302767) :
For: PROTEIN IMMOBILIZATION METHOD :
AND QUANTIFICATION METHOD :

DECISION

This is a decision on the renewed petition under 37 CFR 1.78(a)(3) filed 28 March 2010, to accept an unintentionally delayed claim for the benefit of priority to the prior-filed international applications set forth in the amendment filed with the petition.

The renewed petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR §§ 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. §§ 120 and 37 CFR §§ 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR §§ 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

In this case, the renewed petition still does not satisfy item (1) above. Applicants submitted an amendment to the specification that states:

This application is a U.S. national stage application which claims priority under 35 USC §119 and 35 USC §120 to the following international application designating the United States: PCT/JP2004/000504, filed on January 21, 2004 which is a priority application of the instant application, and this application also claims priority under 35 USC §119 to

PCT/JP2005/000737, filed on January 21, 2005.

As previously noted, 37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional or international application designating the U.S. applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional or international application.

Here, the amendment to the specification still does not identify the proper relationship of PCT/JP2004/000504 to the instant application. Moreover, the claim of priority to PCT/JP2005/000737 under 35 USC §119 is not allowed. The present application cannot claim benefit under 35 U.S.C. 119 to this application because both applications have the same filing date. See MPEP § 1893.03(c), next to last paragraph.

Before the petition under 37 CFR § 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet (37 CFR 1.76(a)(5)) or a proper amendment (complying with the provisions of 37 CFR 1.121) to correct the above matters are required. In addition, the improper incorporation by reference statements must be removed.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web, by facsimile to the Office of PCT Legal Administration at (571) 273-04559, or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Any questions concerning this matter may be directed to James Thomson at (571) 272-3302.



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